

S/N 10/806,367
Vincent C. Moyer, et al.
Atty Dkt: 10040349-1

REMARKS

Claims 1-27 were pending in the application prior to the amendment presented in this response. Claim 17 has been amended herein. Claims 1-16 and 18-27 remain in the application unchanged. Accordingly, after entry of the amendment, claims 1-27 will remain pending. Re-examination and reconsideration are requested.

I. Rejection of Claim 6 Under 35 U.S.C. §103(a)

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson (U.S. Patent No. 4,794,384). Reconsideration of the Examiner's rejection is respectfully requested.

Applicants' claim 6 recites the following:

A method of detecting contaminants with an optical mouse, the method comprising:

- aligning an optics module of a mouse with an imaging surface;
- obtaining a first image of the imaging surface, via application of substantially coherent illumination from the optics module to the imaging surface;
- analyzing the first image to identify an interference pattern associated with a contaminant; and
- identifying the interference pattern as a contaminant if a parameter of the interference pattern exceeds a threshold value.

Claim 6, thus, recites "analyzing the first image to identify an interference pattern associated with a contaminant...". This limitation is neither disclosed nor suggested by the Jackson reference. Although Jackson generally discusses optical interference, there is no disclosure or suggestion in the reference of analyzing an image to identify an interference pattern associated with *a contaminant* as required by claim 6.

Claim 6 further recites "identifying the interference pattern as a contaminant if a parameter of the interference pattern exceeds a threshold value." Regarding this limitation, the Examiner states the following on page 3 of the Office action:

Jackson does not clearly [teach that] the [interference] pattern exceeds a threshold value. However, it would be obvious for one skill in the art to recognize that for an optical mouse to identify the interference pattern as a contaminant if a

parameter of the interference pattern exceeds a threshold value in order to detect contaminant.

The Examiner, thus, admits that Jackson does not disclose the limitation in question, but takes the position, nevertheless, that the limitation would be obvious. Applicants respectfully disagree with the Examiner's position. As discussed above, Jackson does not even contemplate looking for or identifying a contaminant. Accordingly, it is not obvious in view of Jackson to identify an "interference pattern as a contaminant if a parameter of the interference pattern exceeds a threshold value" as recited in claim 6.

Further, applicants' use of a threshold value to identify a contaminant, as recited in claim 6, is not a matter within the knowledge of a person of ordinary skill in the art and the Examiner has submitted no evidence to the contrary. Accordingly, there is absolutely nothing in the file history of this prosecution to support the Examiner's position regarding obviousness. There must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would be obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure." *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988).

For at least the reasons advanced above, applicants respectfully assert that a *prima facie* case of obviousness has not been established with respect to claim 6 and that, therefore, claim 6 is in condition for allowance.

II. Rejection of Claims 1, 17, 18 and 20 Under 35 U.S.C. §103(a)

Claims 1, 17, 18 and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson (U.S. Patent No. 4,794,384) in view of Chang et al. (U.S. Patent Application Publication No. 2004/0246232). Reconsideration of the Examiner's rejection is respectfully requested.

Claim 1

Applicants' claim 1 recites the following:

A method of neutralizing contaminants for an optical mouse, the method comprising:

providing a mouse containing an optics module including an at least partially coherent light source with at least one surface of the optics module exposed to an opening of the mouse; and

interposing a barrier in the mouse between a contaminant and the at least one exposed surface.

Applicants respectfully assert that the rejection of claim 1 is improper because there is no motivation to combine the references as proposed by the Examiner. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 119 F.3d 953, 957, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997).

Claims 17, 18 and 20

Applicants' independent claim 17, as amended herein, recites the following:

A contaminant-resistant optical mouse, the mouse comprising:
a housing having a surface with an opening;
an optics module including a substantially coherent light source disposed within the housing with at least one surface of the optics module exposed to the opening of the housing; and
a barrier structure between the at least one exposed surface and an environment external to the opening.

Claim 17 has been amended herein to correct a minor typographical error.

Claim 17 is allowable for at least the same reasons advanced above with respect to claim 1. Claims 18 and 20 are allowable at least as ultimately depending from allowable base claim 17.

III. Rejection of Claims 2 and 18 Under 35 U.S.C. §103(a)

Claims 2 and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Jackson (U.S. Patent No. 4,794,384) in view of Chang et al. (U.S. Patent Application Publication No. 2004/0246232) and further in view of Bean et al. (U.S. Patent Application Publication No. 2002/0180880). Reconsideration of the Examiner's rejection is respectfully requested.

Claims 2 and 18 are allowable at least as ultimately depending from allowable

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base claims 1 and 17, respectively.

IV. Claims Withdrawn From Consideration

Claims 3, 4, 5, 7-16 and 21-27 remain pending in the application; however, on page 1 of the Office action, the Examiner indicates that these claims have been withdrawn from consideration as being drawn to nonelected species.

Although not listed by the Examiner, claim 19 is also believed to be withdrawn since it is not rejected and contains subject matter similar to claim 4, which is listed.

For at least the foregoing reasons, applicant respectfully asserts that all of the active claims are in condition for allowance.

Respectfully submitted,
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